

Remarks

Claim Rejections Under 35 USC 103(a)

Claims 1-10 are rejected as being unpatentable over Neuhaus et al (Neuhaus) in view of Ueda et al (Ueda) and specification pages 1-2.

Claims 11 and 12 stand rejected over Neuhaus, in view of Ueda and further in view of Butler et al (Butler)

Valid rejection under 35 USC 103(a) requires evidence of a suggestion or motivation for one skilled in the art to combine prior art references to produce the claimed invention. US Court of Appeals for the Federal Circuit (*Ecolochem inc. v Southern California Edison Co., Fed. Cir.*, No. 99/1043, 9/7/00).

The best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for showing a teaching or motivation to combine the prior art references, according to the court.

Neither Neuhaus nor Ueda motivate or suggest to one skilled in the art to combine these references to produce Applicant's claimed invention.

Recently, in *In Re Sang-Su Lee* (00-1158) the Court of Appeals for the Federal Circuit rendered a decision confirming the above principles. The court analyzed 35 USC 103 requirements starting from the Administrative Procedure Act and held (citations omitted):

“Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies.

“The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of “reasoned decision making.” Not only must an agency’s decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

“As applied to the determination of patentability vel non when the issue is obviousness, it is fundamental that rejections under 35 USC §103 must be based on evidence comprehended by the language of that section. (Emphasis added). When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. (Emphasis added)

“The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. Teachings of references can be combined only if there is some suggestion or incentive to do so.”

As stated above, Neuhaus and Ueda do not motivate or suggest to a person skilled in the art to combine these references to duplicate the claims of the present invention.

The basic idea for the present invention is to use a polymer film with information on it for processing forgery-proofed documents. The polymer film with the information, for example a hologram, is a very thin film and is provided with supporting films arranged at least on both sides for further processing after the polymer film is treated by a laser.

Starting from this point an object of the invention is to replace the supporting film by substrates so that a new laminate is built which is suitable for further processing for forgery-proofed documents as for example identification cards or security documents.

This object is achieved according to the invention by the process according to claim 1.

Due to this process a secure replacement of the supporting films by the substrates is possible without damaging the very thin and highly sensitive polymer film. Due to the fact that in the first processing station the polymer film, at least one supporting film, is provided on one side and in the second processing station at least one substrate is provided on one side of the polymer film, which will support and transport the polymer film through the processing stations, a handling of the already exposed polymer film is possible without any stretching or damaging.

After the substitution of the supporting films by the substrates a new laminate is created, which is prepared for further processing and for integrating or completing forgery-proofed documents.

Therefore, a person of ordinary skill in the art the time the present invention was made would not combine the prior art of Neuhaus in view of Ueda. Those two documents relate to different technical fields which are not comparable with the present one.

Neuhaus describes only a final lamination process of a transparent foil to a photosensitive film or information career which is supported by a support layer as described in column 10, line 26 to 36 and 44 to 45 to create security cards.

Ueda relates to duplicating hologram for use of hologram seals. For creating a hologram according to Ueda, it is important that the photosensitive film is positioned to the originally plate cylinder 35. A delamination roller 37 positioned before the originally plate cylinder delaminates the photosensitive material side of the photosensitive material. (Column 9, line 11 to 15)

Therefore, Ueda relates to creating or duplicating holograms and discloses only that a protective film is laminated on the photosensitive material side of the photosensitive material film.

The present invention, however, does not claim duplicating hologram or delaminating a base film for duplicating a hologram and afterwards laminating on the photosensitive material side of the photosensitive material a protected film.

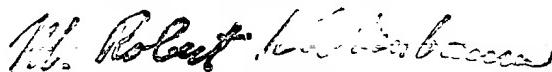
The invention, however describes the process for substituting the supporting film of polymer film already having the information by substrates to proved a laminate for further processing.

Therefore, a man skilled in the art does not pick out separate steps of each complete process of Neuhaus creating a final product and of Ueda duplicating holograms.

Such a construed combination according to paragraph 7 of the office action is only possible if the present invention is already known. Such a hindsight view is however not admissible to show that the invention might be obvious. This argumentation confirms that an inventive step is disclosed.

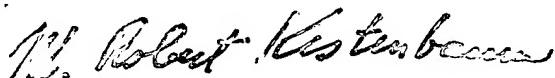
Wherefore, further consideration and allowance of the claims is respectfully requested. This Further Amendment After Final Action is necessary to place the application in condition for allowance or in better condition for appeal.

Respectfully Submitted,



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I hereby certify this correspondence is being submitted to Commissioner for Patents, Alexandria, Virginia 22313-1450 by facsimile transmission on September 4, 2003, fax number (703) 872-9306.



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